

REMARKS

In the Office Action, claims 1 - 21 were noted as pending in the application. Claims 18 - 21 were withdrawn from consideration through a provisional election, and claims 1 - 17 were rejected. By this amendment, no claims have been canceled, claim 11 has been amended, and new claims 22 - 23 have been added. Thus, claims 1 - 17, 22, and 23 are under consideration in the application. The rejections of the Office Action are traversed below.

Restriction Requirement

On March 14, 2005, the Examiner called the undersigned and indicated that the present application was subject to a restriction requirement. In particular, the invention was restricted to either Group I, comprising claims 1 - 17 to a method of adhesion or Group II, comprising claims 18 - 21 to an article. On March 15, 2005 the undersigned called the Examiner and elected Group I, comprising claims 1 - 17, with traverse.

The Office Action asserts that the inventions recited in Group I and Group II are related as a process of making and a product made. The Office Action further asserts that a restriction of the claims is proper because the product as claimed can be made by another and materially different method, including supplying the adhesive separately without the use of the frame as claimed.

The Applicants respectfully assert that the Office Action, contrary to the requirements of MPEP §806.5(f), has failed to document a method other than the method recited in claim 1 for producing the article recited in claim 18. In particular, the Office Action asserts, without support, that the article of claim 18 can be made by supplying the adhesive separately without the use of the frame. The Applicants respectfully disagree. Claim 18 is directed to an article produced by means of the method according to claim 1. Claim 1, in turn, specifically recites a method for the adhesion of windowpanes using a frame with sealing lips, wherein the adhesive is pressed through an opening in the frame into a space bounded by a sealing lip and the windowpane. The claimed method and the resulting product is clearly disclosed in the specification at least at paragraphs 27, 28, 44 and Fig. 2 for adhering a windowpane to a frame. In the absence of the frame, as suggested by the Examiner, the resulting article would be a

sealing lip adhered to a windowpane, which is not the product recited in claim 18 and disclosed in the specification.

In the absence of a specific showing of a materially different method of producing a windowpane adhered to a frame with a sealing lip, as required by MPEP §806.05(f), the Applicants respectfully assert that imposition of a restriction requirement on claims 1 - 21 is improper. Therefore, withdrawal of the restriction requirement and examination of all claims, namely claims 1 - 23, is respectfully requested.

Rejection of Claim 11 under 35 USC §112

On pages 3 - 4 of the Office Action, claim 11 was rejected under 35 USC §112, second paragraph, as being indefinite. This rejection is respectfully traversed.

Claim 11 has been amended herein to recite that the adhesive's setting time exhibits between 1 and 20 minutes, thereby reciting a single range of time. The Applicants thank the Examiner for her clear discussion of the rejection of claim 11 and respectfully request the withdrawal of the rejection of claim 11 under 35 USC § 112 in view of the present amendment.

Claim Construction

On page 4 of the Office Action, the Examiner states that patentable weight has not been given to the preamble language of the claims in rejecting claims 1 - 17. While the Applicants are not certain what the Examiner means by stating that the preamble language "has not been given patentable weight in making the rejections," the Applicants respectfully traverse such a position to the extent the preamble of the claims has been ignored by the Examiner.

While a determination of whether a preamble limits a claim is to be made on a case-by-case basis in light of the facts of each case, a claim preamble "has the import that the claim as a whole suggests for it," and "the claim preamble must be read in the context of the entire claim." MPEP §2111.02. In the present case, independent claim 1 recites a method for the adhesion of windowpanes (1) using a frame (3) that exhibits sealing lips (2). The following steps of the claim proceed to recite the limitations of adhering the windowpane to the frame having at least one sealing lip. The context of the claim, as specified in the preamble and as supported by the

specification, cannot be ignored as the Examiner would chose to do in the present Office Action by the application of a reference (the Kramer '153 patent) that has nothing whatsoever to do with the adhesion of windowpanes to a frame. Accordingly, the Applicants respectfully request removal of the claim construction assertion made on page 4 of the Office Action.

Rejection of Claims 1 - 6, 8, and 10 under 35 USC §102

On pages 4 - 5 of the Office Action, claims 1 - 6, 8, and 10 were rejected under 35 USC §102 as being anticipated by U.S. Patent 5,196,153 to Kramer. This rejection is respectfully traversed.

The Kramer Patent

Kramer discloses a process for securing a handle to a wall of a crockery or pottery article (Kramer at abstract; Col. 3, lines 15 - 18). The handle, or grip, or knob, includes a series of groves on the bottom which become filled with adhesive for adhering the handle to the lid of the crockery (Col. 3, lines 45 - 50; Fig. 1). The adhesive is retained within the groves for securely holding the knob to the lid both by adhesion and by mechanical lock (Col. 4, lines 4 - 8).

The Claimed Invention is Patentably Distinguishable Over Kramer

The Applicants' claimed invention is directed to a method for the adhesion of windowpanes using a frame with sealing lips. In particular, and reciting the elements of independent claim 1, there is claimed a method for the adhesion of windowpanes using a frame that includes sealing lips, including the steps of:

contacting the windowpane (1) with sealing lip (2);
pressing in the adhesive (6) through at least one opening (4) in the frame into a hollow space (5) that is bounded by at least a sealing lip and a windowpane; and
hardening the adhesive (6).

The Office Action cites to Kramer as disclosing each of the features recited in claim 1.

The Applicants respectfully assert that the Office Action's reliance on Kramer is misplaced. First, Kramer has nothing whatsoever to do with the adhesion of windowpanes, much less the adhesion of windowpanes using a frame with sealing lips. Instead, Kramer is directed toward gluing a handle onto the lid of a piece of crockery (Kramer at abstract; Col. 3, lines 15 - 18; Fig. 1). In contrast, the present method is clearly recited and disclosed as being a method for the adhesion of windowpanes to a window frame, where adhesive is pressed through an opening in the frame to secure the windowpane to the frame (see specification at paragraph 27). The windowpanes comprise essentially transparent plates made of glass or plastic that are to be fixed in an automobile or a building (paragraph 26). The frames onto which the windowpanes are glued comprise a body that is part of a structure, such as a vehicle or a building (paragraphs 27 and 28).

The purported frame (1) of Kramer is merely the base of the knob being glued to the crockery lid, not the frame to which the windowpane of the present invention recited in claim 1 is being adhered. In fact, once the knob of the Kramer lid is glued onto the lid, the lid is free to be removed by a user from the crockery (Kramer at Col. 1, lines 14 - 36; Col. 3, lines 65 - 66; Fig. 2). Further, the structure to which the windowpane (1) is being adhered in the present system is the frame (3). In contrast, the Office Action correctly points out that the item (1) being adhered to the glass is separate and distinct from the structure (7) supporting the glass (see Kramer at Col. 3, lines 25 - 27; Fig. 1).

It is respectfully submitted that Kramer fails to disclose each of the features recited in claim 1; and, therefore, Kramer cannot reasonably be said to anticipate Applicants' claimed invention. Accordingly, claim 1 is believed to be patentably distinguishable over the Kramer document, and it is respectfully requested that the rejection of claim 1 be withdrawn.

Claims 2 - 6, 8, and 10 depend from claim 1 and include all the features of claim 1 plus additional features which are not taught or suggested by the Kramer document. For example, claim 8 specifies that in the cross-section to the windowpane and to the adhesion, the single sealing lip, at least, exhibits the hollow space (5) in a concave form, which is bounded by at least one sealing lip and windowpane, in the area of the transition between the sealing lip (2) and the windowpane (1), which is neither taught nor suggested by Kramer. Instead, Kramer discloses

that the undercut annular grooves (13) filled with adhesive are bounded by additional adhesive (16) and not the windowpane (see Kramer at Col. 3, lines 45 - 50; Col. 4, lines 4 - 6 and 19 - 22; Fig. 2). Therefore, for at least this reason and the reasons set forth above with respect to claim 1, it is submitted that claims 2 - 6, 8, and 10 patentably distinguish over the Kramer document, and withdrawal of the rejection of claims 2 - 6, 8, and 10 is respectfully requested.

Rejection of Claims 1, 7, 9, and 11 - 17 under 35 USC §103

On pages 5 - 7 of the Office Action, claims 1, 7, 9, and 11 - 17 were rejected under 35 USC §103 as being unpatentable over U.S. Patent 5,196,153 to Kramer. This rejection is respectfully traversed.

The Claimed Invention is Patentably Distinguishable Over the Kramer Document

The Office Action admits that Kramer fails to disclose a frame of elastic material and further fails to disclose the additional specific features recited in claims 7 and 12 - 15. The Applicants not only agree that Kramer fails to disclose each of the elements recited in claims 7 and 12 - 15 but also assert that Kramer fails to disclose the elastic sealing lips (2) as recited in claim 7. Further, since Kramer relies on a mechanical lock as characterized by the solidified adhesive in the grooves of the lips separating the grooves 13, the Applicants respectfully assert that constructing the Kramer lips of an elastic material would actually teach away from the mechanical lock designed into the Kramer system (see Kramer at Col. 3, line 65 - Col. 4, line 8; Fig. 1).

The Office Action attempts to overcome the deficiencies of the Kramer reference by asserting, without support, that the person of ordinary skill in the art would include any conventional material to produce the desired product properties and material availability. The Applicants respectfully submit that, under a rejection based on 35 USC §103, the Examiner bears the burden of showing a *prima facie* case of obviousness based on the prior art and can satisfy this burden only by showing some objective teaching or that knowledge generally available to one of ordinary skill in the art would motivate the combination or modification of relevant teachings, such as the Kramer document. No such showing has been made in the present Office

Action, and the Applicants respectfully request the Examiner cite a reference supporting her assertions of obviousness pursuant to MPEP §2144.03.

The Applicants respectfully notes the present Office Action has relied on the Kramer document and assertions of obviousness to reject claim 11, but has presented no analysis regarding how the feature recited in claim 11 are rendered obvious by the Kramer reference, contrary to the requirements of 37 CFR §1.104(c); MPEP §706.

Claims 7, 9, and 11 - 17 depend from claim 1 and include all the features of claim 1 plus additional features which are not taught or suggested by the Kramer document. For example, claim 14 specifies that the frame is constructed essentially of wood or lacquered wood, which is neither taught nor suggested by Kramer. The Office Action has asserted on page 6 that the use of wood would have been an obvious choice to the person of ordinary skill based on the desired product properties. The Applicants respectfully disagree and assert that the person of ordinary skill in possession of the teaching of Kramer would be directed away from the use of wood because Kramer expressly asserts that the handle and adhesive of its crockery are intended for use in microwaves and must be able to withstand cooking temperatures in excess of 100°C (see Kramer at Col. 1, lines 14 - 41). Therefore, for at least this reason and the reasons set forth above with respect to claim 1, it is submitted that claims 7, 9, and 11 - 17 patentably distinguish over the Kramer document, and withdrawal of the rejection of claims 7, 9, and 11 - 17 is respectfully requested.

New Claims

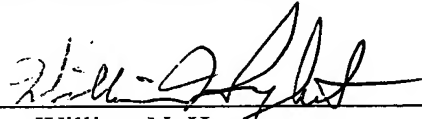
Claims 22 and 23 have been added to provide additional claim coverage for the present invention. Support for the new claims can be found in the specification at least at paragraphs 25, 26, 31, 43, 44, 47, and 54.

Summary

It is submitted that none of the documents, either taken alone or in combination, teach the claimed invention. Thus, claims 1 - 17, 22, and 23 are deemed to be in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited. If any fees are required in connection with this Amendment, please charge the same to our Deposit Account No. 50-2518.

Respectfully submitted,

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